

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 97-022-F3)

In application of)
Dunlay, et al.)
Patent No. 7,565,247)
Serial No. 09/718,770)
Issued: July 21, 2009)
Filed: November 22, 2000)
For: A Method for Acquisition, Storage,)
And Retrieval of Cell Screening)
Data on a Computer System)
Examiner: Carolyn Smith)
Group Art Unit: 1631)
Confirmation No.: 5398)

Mail Stop **Patent Ext.**
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705**

Sir:

Applicants respectfully submit the following revised Request for Reconsideration of Patent Term Adjustment (PTA) in the above-referenced U.S. Patent No. 7,565,247, issued July 21, 2009. Applicants previously submitted a Request for Reconsideration of Patent Term Adjustment on February 3, 2009, concurrent with the submission of the Issue fee under Notice of Allowance. Applicants received a response to this petition on June 18, 2009 holding the decision in abeyance until after the actual patent date. Applicants are submitting this revised request within TWO MONTHS of the issue date of the patent. The fee under 37 C.F.R. § 1.18(e) (\$200) was submitted with the previous petition (February 3, 2009) and thus no further fee is believed due. If other fees are associated with the instant request for reconsideration, the Commissioner is authorized to charge the fee(s) to our deposit account 13-2490.

REMARKS & REQUEST

Responsive to the Determination of Patent Term Adjustment posted on the Patent Application Information Retrieval System (PAIR) and provided with the Issue Notification, mailed July 1, 2009, and in light of the recent ruling in *Wyeth v. Dudas*, No. 07-1492, slip op. (D.D.C. Sept. 30, 2008) the Patentees submit this Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705. As stated in 37 C.F.R. 1.705(b) and (d):

(b) Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance.

(d) If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues.

Applicants previously submitted a Request for Reconsideration of Patent Term Adjustment on February 3, 2009, concurrent with the submission of the Issue fee under Notice of Allowance and pursuant to 37 C.F.R. 1.705(b). Applicants received a response to this petition on June 18, 2009 holding the decision in abeyance until after the actual patent date. Applicants are submitting this revised request within TWO MONTHS of the issue date of the patent pursuant to 37 C.F.R. 1.705(d). Thus, Applicants contend this request is timely.

The data available on PAIR indicates that the instant application has been granted 1392 days of Patent Term Adjustment. Applicants submit that, due to the recent *Wyeth*

decision, the correct Patent Term Adjustment should be 2059 days ($1392 + 667 = 2059$). Applicants, therefore, request that the above-captioned allowed application be granted an additional 667 days of patent term.

Applicants agree with the Patent Office's initial determination, which, for purposes of this request and in keeping with the explanation provided in *Wyeth*, Applicants will refer to as the "A delay." In the "A delay" the Patent Office delayed prosecution by issuing the first communication (Office Action, September 30, 2004) 14 months plus 982 days after the filing of the application (37 CFR 1.703(a)(1)); by issuing a further Office Action (September 2, 2005) 4 months plus 39 days after the filing of a reply (37 CFR 1.703(a)(2)); by issuing a BPAI decision 629 days after the filing of a Notice of Appeal (37 CFR 1.703(4)); and by issuing the patent 4 months plus 48 days after the filing of the issue fee (37 CFR 1.703(a)(6)), resulting in a USPTO "A delay" of 1698 total days.

In the "A delay" the Patentees delayed prosecution by filing a response to an Office Action 3 months plus 85 days after the mailing of the respective action (Response filed, March 25, 2005)(37 CFR 1.704(b)); by filing a supplemental response 90 days after the filing of the initial response (Response filed, June 23, 2005) (37 CFR 1.704(c)(8)); by filing a response to an Office Action 3 months plus 61 days after the mailing of the respective action (Response filed, February 1, 2006)(37 CFR 1.704(b)); by filing a response to an Office Action 3 months plus 61 days after the mailing of the respective action (Response filed, September 6, 2006)(37 CFR 1.704(b)); and again by filing a Notice of Appeal in response to an Office Action 3 months plus 9 days after the mailing of the respective action (NOA filed, February 15, 2007 (37 CFR 1.704(b)). Therefore the Patentees were responsible for a total of 306 days delay. These delays result in a total "A delay" of 1392 days ($1698 - 306 = 1392$).

The Patent Office however has **not** included in the Patent Term Adjustment the days related to the "B delay," which are the days delay resulting from an application pending longer than three years. According to 37 C.F.R. 1.703(b):

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the

national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued...

The instant application was filed on November 22, 2000. As noted above, Applicants filed a request for continued examination (RCE) on September 6, 2006 which is 3 years plus 1019 days after the filing date.

However, the *Wyeth* decision states that “the ‘A period’ and ‘B period’ overlap only if they occur on the same calendar day or days” (*Wyeth*, No. 07-1492, slip op. at 8). There were two overlap periods, in which the “B delay” overlapped calendar days with the “A delay.” In the first overlap the days between November 23, 2003 (the day that is the date that is three years after the date on which the application was filed) and the issuance of the first Office Action on September 30, 2004 is 313 days and has already been included in the “A delay” outlined above. In the second overlap, the days delay between the filing of a reply (March 25, 2005) and the issuance of a further Office Action (September 2, 2005) is 39 days and has already been included in the “A delay” as outlined above. Thus, the resulting “B delay” is 667 days ($1019 - 313 - 39 = 667$).

Thus, according to the *Wyeth* decision, Patentees are entitled to both the “A delay” of 1692 days and the “B delay” of 1019 days minus any overlap which occurs on the same calendar days (352 days), and minus any Applicant delay (306 days). Thus, the total Patent Term Adjustment due to both the “A” and “B” delays and minus any overlap and Applicant delay is 2059 days ($1698 + 1019 - 306 - 352 = 2059$).

For these reasons, the Patent Term Adjustment for this case should be 2059 days.

In light of the foregoing, the Applicants respectfully request that an additional 667 days of Patent Term Adjustment be added to the patent term for Patent Office delay, resulting in a total Patent Term Adjustment of 2059 days. If a telephone conference would expedite the prosecution of this Request for Reconsideration of Patent Term Adjustment, please contact the undersigned as indicated below.

Required statement under 37 C.F.R. § 1.705(b)(2)(iii) – The above-referenced allowed patent application is not subject to any terminal disclaimer.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff LLP

Date: July 22, 2009

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